

REMARKS

Applicants hereby traverse the current rejections, and request reconsideration and withdrawal in light of the remarks contained herein. Claims 4, 9, 12, 18, 23, 25, and 29 are indicated as having allowable material. New claims 30-32 are provided for consideration. Claims 1-9 and 11-32 are pending in this application.

Title

The Examiner has objected to the current title as not being descriptive of the claimed invention. In response, Applicants have amended the title to be descriptive of the claimed invention. Applicants respectfully request withdraw of this objection.

Double Patenting

Claims 1, 15, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13, and 24, respectively of U.S. Patent No. 6,725,317.

Applicants propose filing a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) if the Examiner's rejection still properly stands upon an indication of allowability of the claims over the prior art of record.

Rejections under 35 U.S.C. § 103

Claims 1-3, 5-8, 11, 13-17, 19-22, 24, and 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okazawa et al. ('021, hereinafter Okazawa) in view of Kleinsorge et al. ('734, hereinafter Kleinsorge).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

Lack of Motivation

The Office Action admits that Okazawa does not teach having the service processor and each cell board maintain a copy of the data that describes the configuration for the computer system. The Office Action attempts to cure this deficiency by introducing Kleinsorge, which the Office Action alleges to teach having such elements. The motivation for making the combination was presented as follows:

“It would have obvious ... to have combined the teachings of Kleinsorge et al. into the teachings of Okazawa et al. because it would [sic] a flexible computer system having maximum resource availability and scalability.”

It is well settled that the proposed modification cannot change the principle operation of a reference, M.P.E.P. § 2143.01. Okazawa discloses having an active partition and a standby partition, such that when a fault occurs the system replaces the active partition with the standby partition. Thus, in Okazawa, only one partition is running at any moment. Kleinsorge is a multiple partition system, with more than one partition operating at a given moment. Since Okazawa and Kleinsorge each operate on different principles, the suggested combination of references would require a substantial reconstruction and redesign of the elements of Okazawa, as well as a change in the basic principle under which the system of Okazawa was designed to operate. The M.P.E.P. clearly states that such substitution is impermissible, see M.P.E.P. § 2143.01.

It is also well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The motivation provided to include the teaching of Kleinsorge with system of Okazawa is insufficient for the modification being proposed. Okazawa already has a system that is flexible and has maximum resource availability. Okazawa discloses having an active partition and a standby partition, such that when a fault occurs the system replaces the active partition with the standby partition. Thus, the system of Okazawa is capable of operations after incurring a fault. Thus, the system is flexible and has resource availability. Okazawa is also scaleable in that a partition may be expanded, see column 11, line 36 and Figure 16. Thus, the language

of the motivation statement merely indicates that the Okazawa can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Okazawa and Kleinsorge is desirable. Therefore, the rejection of claims 1-3, 5-8, 11, 13-17, 19-22, 24, and 26-28 should be withdrawn.

Lack of Limitations

The Office Action admits that Okazawa does not teach having the service processor and each cell board maintain a copy of the data that describes the configuration for the computer system. The Office Action attempts to cure this deficiency by introducing Kleinsorge, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a computer system wherein the service processor stores a copy of the data that describes the configuration for the computer system. The Office Action admits that Okazawa does not teach such a limitation. The Office Action relies on Kleinsorge only for teaching that “each cell board maintains a copy of the data”. See the Office Action, page 5. Thus, in the combination of references, the rejection fails to teach having the service processor store a copy of the data that describes the configuration for the computer system. The Office Action is silent as to a source for teaching having the service processor stores a copy of the data that describes the configuration for the computer system. Thus, the combination of Okazawa and Kleinsorge does not teach all of the claimed limitations, as stated by the Office Action. Therefore, the Applicants respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 15 defines method the comprises storing a copy of the data in the service processor. The Office Action admits that Okazawa does not teach such a limitation. The Office Action relies on Kleinsorge only for teaching that “each cell board maintains a copy of the data”. See the Office Action, page 5. Thus, in the combination of references, the rejection fails to teach storing a copy of the data in the service processor store. The Office Action is silent as to a source for teaching the claimed storing. Thus, the combination of Okazawa and Kleinsorge does not teach all of the claimed limitations, as stated by the Office Action. Therefore, the Applicants respectfully asserts that for the above reasons claim 15 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 27 defines a computer system wherein the service processor stores a copy of the data that describes the configuration for the computer system. The Office Action admits that Okazawa does not teach such a limitation. The Office Action relies on Kleinsorge only for teaching that “each cell board maintains a copy of the data”. See the Office Action, page 5. Thus, in the combination of references, the rejection fails to teach having the service processor store a copy of the data that describes the configuration for the computer system. The Office Action is silent as to a source for teaching having the service processor stores a copy of the data that describes the configuration for the computer system. Thus, the combination of Okazawa and Kleinsorge does not teach all of the claimed limitations, as stated by the Office Action. Therefore, the Applicants respectfully asserts that for the above reasons claim 27 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-3, 5-8, 11, 13-14, 16-17, 19-22, 24, 26, and 28 depend from base claims 1, 15, and 27, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-3, 5-8, 11, 13-14, 16-17, 19-22, 24, 26, and 28 sets forth features and limitations not recited by the combination of Okazawa and Kleinsorge. Thus, the Applicants respectfully assert that for the above reasons claims 2-3, 5-8, 11, 13-14, 16-17, 19-22, 24, 26, and 28 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

New claims 30-32 depend from base claims 1, 15, and 27, respectively, and thus inherit all limitations of their respective base claims. No new matter has been entered as

basis for these amendments exists in the present specification and drawings, for example see Figure 5 and the related text. New claims 30-32 set forth features and limitations not recited by the prior art of record. Thus, the Applicants respectfully assert that new claims 30-32 should be indicated as being allowable over the prior art of record.

The Examiner is thanked for the indication that claims 4, 9, 12, 18, 23, 25, and 29 include allowable subject matter.

For all the reasons given above, the Applicants submit that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, the Applicants submit that this application is in full condition for allowance.

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

The required fee for this Response is shown on the transmittal sheet. If any additional fee is due, or at any time during the pendency of this application, please charge any additional fees required or credit any overpayment to Deposit Account No. 08-2025, under Order No. 10001728-3 from which the undersigned is authorized to draw.

Dated: June 24, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482710243US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 24, 2005

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Respectfully submitted,

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